

To: MAIL STOP RCE

From: Leslie Ray for Michael J. Villa

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Attorney Docket: 012.P59001

JAN 19 2007.

REMARKS

Claims 1-2 and 42-48 are pending in the above-referenced patent application. In this response, claims 14-41, which were withdrawn in an amendment filed July 10, 2006 in response to a restriction requirement have been formally cancelled without prejudice in response to a requirement by the Examiner requiring cancellation of all non-elected claims. Assignee reserves the right to pursue subject matter of claims 14-41 in a divisional application. Accordingly, no prosecution history should result from the cancellation of claims 14-41. Additionally, in this response, claims 1-2 have been amended and claims 42-48 have been added. It is respectfully submitted that adequate support for the amendments to claims 1-2 and new claims 42-48 may be found in the specification, figures, and claims as filed. Additionally, it is noted that claims 1-2 were not amended in light of cited art, but, rather, were amended to more clearly delineate intended subject matter.

Claim Rejections – 35 USC §103(a)

The Examiner has rejected claims 1-2 under 35 USC §103(a) as being unpatentable over Busking et al (U.S. Pat. No. 6,107,684, hereinafter “Busking”) in view of Gonda (U.S. Pat. No. 4,924,195) and Seshita (U.S. Pat. No. 6,366,770). These rejections are respectfully traversed.

Assignee respectfully submits that claims 1-2 are not rendered obvious over Busking in view of Gonda and Seshita. It is noted that in order to establish *prima facie* obviousness there must be some suggestion or motivation to modify or combine reference teachings, and the combination, if successful, must teach or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” It is respectfully submitted

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that the cited references do not meet these criteria. For example, the cited art, alone or in combination, does not teach or suggest all the claim limitations.

For example, Busking fails to teach or suggest all the claim limitations of the rejected claims, and Gonda and Seshita fail to cure the deficiencies of Busking. Accordingly, any combination of Busking in view of Gonda and Seshita would still not teach or suggest all the claim limitations. However, Assignee does not by this argument accept that the combination is proper; rather, while Assignee does not admit that the combination is proper, Assignee further asserts that even if the combination were proper, and a successful combination of Busking, Gonda and Seshita were made, any resultant combination or any of the other alleged combinations would still not teach or suggest all the claim limitations of the rejected claims.

Referring first to Busking, Assignee respectfully submits that Busking does not teach or suggest at least the elements noted above. Busking merely teaches an on-chip inductor coupled to a bond wire. The on-chip inductor coupled to the bond wire forms a parallel resonant circuit. See, for example, col 3:15 – col 4:11 of Busking. The bond wire of Busking does not comprise "a series inductor of a series inverter portion of an impedance inverter circuit". As recited in claim 1, as amended.

Although Assignee does not agree with the Examiner's characterization of Busking or of the rejected claims, the Examiner concedes that Busking includes at least one deficiency. For example, as stated in page 3 of the Final Office Action, "Busking .... lacks having the circuit comprising the impedance inverter (claim 2)".

Furthermore, Gonda fails to cure at least the deficiencies noted above. Although Gonda describes an impedance inverter for a crystal oscillator, the impedance inverter of Gonda is not formed from a "wire bond". See, for example, col 1:61 – col 2:12 of Gonda. Therefore, Gonda does not teach or suggest a wire bond comprising "a series inductor of a series inverter portion of an impedance inverter circuit". Accordingly, Gonda does not cure the numerous deficiencies noted in Busking.

Furthermore, Seshita fails to cure at least the deficiency noted above. Although Seshita describes wire bonds, the wire bonds of Sheshita are employed to couple integrated circuit pads with signal pins or directly with a metallic plate of an integrated circuit package in order to reduce parasitic

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inductance problems, and are not used to form an impedance inverter circuit. See, for example, col 5:17 – 6:27 of Seshita. Therefore, Sheshita does not teach or suggest a wire bond comprising “a series inductor of a series inverter portion of an impedance inverter circuit”. Accordingly, Seshita does not cure the numerous deficiencies noted in Busking and Gonda.

Therefore, any combination of Busking in view of Gonda and Seshita would still fail to teach or suggest at least a wire bond comprising “a series inductor of a series inverter portion of an impedance inverter circuit”, as recited in claim 1. Accordingly, it is respectfully submitted that the Examiner has failed to meet the requirements for a *prima facie* showing of obviousness, and claims 1-2 are in a condition for allowance. Additionally, claims 42-48 depend from and include all limitations of claim 1, and are therefore not rendered obvious for at least the same reasons.

Assignee respectfully submits that because a *prima facie* case of obviousness has not been established, all pending claims are in a condition for allowance. It is noted that many other bases for traversing the rejection could be provided, but Assignee believes that this ground is sufficient. Accordingly, it is respectfully requested that the Examiner withdraw these rejections of claims 1-2, and allow all pending claims to proceed to allowance.

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CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application, as amended, are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: 1/19/07

  
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January 19, 2007

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